No. 18.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1903.

SINGER MANUFACTURING COMPANY, *Petitioner,*

vs.

HERMAN CRAMER.

MOTION FOR LEAVE TO FILE PETITION FOR REHEARING.

Now comes Herman Cramer, the respondent in the above entitled case, by John H. Miller, his counsel, and moves this Honorable Court for leave to file a petition for a re-hearing of said case and re-argument thereof before a full bench, which said petition is as follows:

PETITION FOR RE-HEARING.

Herman Cramer, the respondent in the above-entitled case, feeling himself aggrieved by the judg-

ment of the court rendered therein on February 1, 1904, petitions this court for a rehearing thereof on the following grounds:

I.

Because the Court held that the question of infringement in this case was a question of law and not a question of fact, and for that reason was reviewable on writ of error, which holding this respondent claims was error.

II.

Because the Court held that the broad idea of mounting the treadle of a sewing machine in the vertical brace did not involve invention, in view of the fact that prior thereto oscillating and revolving shafts had been mounted in rigid bearings in other kinds of machinery, which holding respondent claims was error.

III.

Because the Court held that Cramer's claim I must receive a narrow construction and be limited to the precise details of mechanism shown and described in the specification and drawings, which holding respondent claims was error.

IV.

Because the point on which the decision is based was not raised or argued by counsel, and the respondent has not been heard thereon.

V.

Because the case was not heard by a full bench, and it is one of such gravity and importance as to make it highly desirable that it should be heard by a full bench.

ARGUMENT ON THE FOREGOING PETITION.

We feel deeply aggrieved at the decision in this case, and as the only means at our disposal for expressing such grievance is a petition for re-hearing, we herewith ask permission of the Court to file one. We are aware that this Court seldom grants a re-hearing. In fact, it has granted only thirteen during its entire existence, and most of those were simply re-arguments ordered by the Court of its own motion. But, notwithstanding these facts, we venture to request of the Court a re-hearing in this case for the reason that the opinion lays down a rule of law which is not only contrary to all the traditions and many adjudicated cases of this Court, but which, if allowed to stand, may be used as an instrument for the oppression of patentees by arbitrarily destroying a

species of property whose enjoyment has been guaranteed by the Constitution.

I.

The first point announced in the decision is that the question of infringement is a pure question of law dependent upon a mere comparison of the Cramer and Diehl patents. The exact language of the Court is as follows:

"As in each of the patents in question it is apparent " from the face of the instrument that extrinsic evi- " dence is not needed to explain terms of art therein, " or to apply the descriptions to the subject matter, " and as we are able from mere comparison to com- " prehend what are the inventions described in each " patent, and from such comparison to determine " whether or not the Diehl device is an infringement " upon that of Cramer, the question of infringement " or no infringement, is one of law and susceptible of " determination on this writ of error."

The entire decision is based upon this premise. If it is wrong, then the decision is wrong. We submit that the same is wrong and contrary to many decisions of this Court, where the true rule is announced.

Just exactly half a century ago the true rule was first announced by this Court in *Battin* vs. *Taggart*, 17 How., 84, in an opinion delivered by Mr. Justice McLean.

Afterwards in the case of *Bischoff* vs. *Wethered*, 9 Wall., 812, in an opinion rendered by Mr. Justice Bradley in 1869, the same ruling was made. No abler judge in patent matters has probably ever sat on the bench than Mr. Justice Bradley, and his opinion rendered in that case is so contrary to the opinion rendered in the case at bar that the two cannot possibly be reconciled. Both of them cannot be right. One of them must be wrong, and we earnestly request of this Court to carefully read Mr. Justice Bradley's language in the case quoted and to say whether or not it was the intention of this Court to overrule that decision. Certainly the legal profession is entitled to know which one of two conflicting decisions is to be their guide in future practice.

Afterwards in 1871, in *Tucker* vs. *Spaulding*, 13 Wall., 453, Mr. Justice Miller in the most emphatic language again laid down the rule which we contend for, specifically affirming *Bischoff* vs. *Wethered*, saying:

"This Court has no more right than the Court be-
"low to decide that one patent covered the invention
"of the other or that it did not."

In *Mitchell* vs. *Tilghman*, 19 Wall., 287, the same rule was announced in an opinion rendered by Mr. Justice Clifford in 1873.

In *Keyes vs. Grant*, 118 U. S., 25, the same identical rule was announced by this Court through Mr. Justice Mathews. That case was decided in 1876.

We also find the same rule announced by this Court in *Royer* vs. *Schultz Belting Co.*, 135 U. S., 319, in an opinion rendered by Mr. Justice Blatchford in 1890.

Five years later, in 1895, we find the same rule announced in *Coupe* vs. *Royer,* U. S., in an opinion rendered by Mr. Justice Shiras.

Thus we see that for the past fifty years it has been the ruling of this Court that in the trial of a patent case before a jury the question of infringement is one of fact and the Court cannot compare the rival specifications and determine for itself as a question of law that there is no infringement.

This ancient rule of law has been followed by the text-writers and embodied in their books as a guide for the profession. See *Curtis on Patents,* Sec. 469; *Robinson on Patents,* Vol. 3, page 378.

It is likewise the rule of law announced by the highest courts of England. See *Hill* vs. *Evans,* 31 L. J. Ch. 463, and *Betts* vs. *Menzies,* 10 H. L. Cas., 117.

Now in view of these authorities, we submit that the opinion in the present case lays down a diametrically opposite rule of law when it says:

"As in each of the patents in question it is apparent from the face of the instrument that extrinsic "evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject matter, and as we are able from mere comparison to "comprehend what are the inventions described in

"each patent and from such comparison to deter-
"mine whether or not the Diehl device is an in-
"fringement upon that of Cramer, the question of in-
"fringement or no infringement is one of law and
"susceptible of determination on this writ of error."

The opinion cites two authorities in support of its doctrine, viz., *Heald* vs. *Rice,* 104 U. S., 737 and *Market Street Cable Company* vs. *Rowley,* 155 U.S., 625.

In our judgment neither of them has any relevancy. In *Heald* vs. *Rice* the question related to the identity of a re-issued patent with the original patent, and such a question has always been held to be a question of law and not one of fact. That is so well settled in the history of patent cases that it would be an act of supererogation for us to burden this petition with citations. In fact, the distinction is pointed out in the opinion in *Heald* vs. *Rice,* which cites *Battin* vs. *Taggart* and *Bischoff* vs. *Wethered,* distinctly intimating that the rule of law was different in the two instances. Mr. Justice Mathews rendered the decision in *Heald* vs. *Rice.* He also rendered the decision in *Keyes* vs. *Grant,* 118 U. S., 25, where a prior patent was set up as an anticipation, and where he distinctly stated that in such cases it was not the province of the Court to compare the two specifications and decide upon their identity as a question of law, but that it was the province of the jury to do that as a question of fact.

In the other case cited, *Market Street* vs *Rowley*, 155 U. S., 625, certain prior patents had been put in evidence as anticipation, *but no extrinsic evidence whatever was given for the purpose of explaining the terms of art used therein or of showing dissimilarities,* and this Court held that under such circumstances, that is to say, where the facts were admitted and there was *no extrinsic evidence* whatever, the question of the construction of those patents became a question of law. That is a far different question from the one here presented. The major part of the evidence offered in the case at bar consisted of extrinsic evidence on the part of Cramer to show similarity, and on the part of the Singer Company to show dissimilarity between the Cramer patent and Diehl device. The testimony of both experts and laymen was taken at great length. There was wide diversity as to the terms of art used in the patent, and diametrically opposite views thereon were advanced by the rival witnesses, thus raising a substantial conflict of evidence, so that the case was not at all similar to *Market Street* vs. *Rowley*.

Furthermore, in *Market Street* vs. *Rowley*, there was a sharp dissenting opinion by Mr. Justice Brown, in which he pointed out the fact that according to the rule laid down in *Battin* vs. *Taggert* and *Bischoff* vs. *Wethered*, the disputed matter should have been submitted to the jury. If so eminent a member of this Court as Mr. Justice Brown was of

the opinion that even in a case where no extrinsic evidence whatever was offered, the matter was one for the jury to decide as a question of fact and not for the Court to decide as a question of law, how is it possible to escape the conclusion that in a case where so huge a mass of extrinsic evidence was offered as in the case at bar, and where such a sharp conflict resulted therefrom, the matter was one of fact for the jury and not a question of law for the Court?

In his dissenting opinion referred to, Mr. Justice Brown stated the following as the true rule of law:

"Indeed, I understand it to be a general rule ap-
"plicable to all trials by jury, that if there be any
"conflict of testimony with regard to a particular
"fact, or if, the facts being admitted, men in the ex-
"ercise of reasonable judgment may derive different
"inferences from such facts, the question is for the
"jury."

We respectfully submit, therefore, that the two cases cited in the opinion in the case at bar not only do not support the theory of the decision, but are both, incidentally at least, contrary thereto. If that theory be erroneous, then clearly the whole opinion following is a *non sequitur*, for in such event the question of fact could not be reviewed by this Court. It is too well settled to admit of discussion that upon a writ of error to this Court in an action at law all contested questions of fact are deemed conclusively settled by the verdict of the jury.

II.

The opinion in the case at bar next proceeds to hold that the Cramer invention is not of a pioneer character such as to justify a broad interpretation of his claim, but is restricted narrowly to the mere details of mechanism described in the patent.

This result is reached by holding that prior to Cramer it was shown by extrinsic evidence to be a well known method of construction, when revolving or oscillating shafts were to be placed in bearings or supports in *other machines,* to have both bearings of such shafts attached to a solid metal casting, and that instances of such were to be found in saw-arbors, engine and machine lathes, and high speed engines. The Court might have added to the list the mounting of a cannon on trunnions, for such a device has been known since the days of Charles the Bold; or the similar mounting of windmills, known since the days of Don Quixote. It is not pretended that such devices were ever found in a sewing-machine. It is also pointed out in the opinion that in sewing-machines the vertical brace was old, though the treadle had never been mounted therein, and that the treadle had been mounted in the side pieces or legs. From these premises the opinion concludes:

"We readily conclude that there was no merit in "the mere conception or idea that a vertical double "brace was capable of being advantageously utilized

"as bearings for sewing machine treadles and that "the devising of means for so utilizing such a brace "did not involve such an exercise of the inventive "faculty as entitled Cramer to assert in himself a "right to claim a patent broadly for the use in com- "bination of a vertical double brace and a sewing "machine treadle."

In other words, the precise contention is that because of the fact that oscillating and revolving shafts had been mounted in solid castings in *saw-mills, machine lathes,* and *high speed engines* (remote and distant arts), it involved no invention in the sewing machine art to mount a treadle in the diagonal vertical brace. This involves the much discussed question of whether or not it is invention to apply an old contrivance to a new use.

1. *This is a question which has never been argued in the case by either side.*

The learned counsel for the Singer Company thought so little of the merits of this contention that they did not mention it in their argument. It is true that at the trial below they produced evidence as to the mounting of shafts in saw-mills, lathes, and steam engines; but it is equally true that very little, if any, reliance was placed upon such evidence, it apparently being their opinion that the devices mentioned were too remote from a sewing machine to constitute a basis for an application of the doctrine of double use. The matter was not adverted to by them in the oral

argument on the trial before the jury, nor upon the argument before the Court of Appeals, nor upon the argument in this Court either oral or printed. Such being the case, we were justified in refraining from arguing the point ourselves, as it was impossible for us to suspect that the Court would seize upon this abandoned point and base its decision thereon. In other words, we have not only been misled, but we have been taken by surprise, and we request an opportunity to argue this proposition of law before the full bench. When a case is decided upon a point not raised or argued, we think it nothing more than just, on application for a re-hearing that the defeated party be given an opportunity to argue that point fully before the Court. *On this particular point we have never been heard.* It may be that if we had been heard, our views would have been of no avail; but, nevertheless, it is the right of every litigant to be heard before judgment is pronounced against him; and in asking for a re-hearing on this point we respectfully submit that we are asking for nothing more than what every litigant, however humble he may be, is entitled to.

2. *The question was one not open to review in this Court.*

Addressing ourselves now to the precise point in hand we venture to make a few remarks thereon. We claim that the first answer to the contention of the Court regarding this question of double use is

that the matter was purely a question of fact for the jury and not a question of law for the Court, and consequently, the decision of the jury thereon is not reviewable on writ of error.

We are perfectly well aware that in several instances, notably in the case of *Pierce* vs. *Mulford*, 102 U. S., 112, this Court has stated that all improvement is not invention, and that to entitle an improvement to protection by a patent it must be the product of the inventive faculty as distinguished from mechanical skill. We note also the further fact that the Courts have held that the term "inventive faculty" is not susceptible of exact definition, and we note that the meaning of this term, so far as the decisions are concerned, is left in profound obscurity.

No two persons can agree as to the exact line of demarcation between invention and mechanical skill, because from variations in the characters of minds and differences in training and experience, a change which to one mind appears to have involved invention is thought by another, after the event, to have involved only mechanical skill. Consequently, to test the existence of invention by the assumption of the exercise of mental faculties by which it has been produced and which are indefinable, amounts simply to an attempted determination of a truth by mere judicial opinion, with no reliance upon evidence and without recourse to those salutary rules established from time immemorial by which and by which alone

a just conclusion can be reached. In other words, to determine the fact of invention or no invention by mere judicial caprice, is an act of tyranny, because such question, being one of fact, can be determined by the rules of evidence just as any other fact can be determined.

To a mind skilled in scientific reasoning the procedure of determining the nature of an effect by the assumption of a cause by which it may or may not have been produced, is contrary to the rules of logic obtainable in all other cases, and therefore, must be contrary to the correct rule in patent cases. The faculties of the mind are forces, and, as with other forces, we know nothing of them except by their effects. We know nothing of the real nature of the forces of electricity and heat. It is true that we have hypotheses that electricity is a fluid of some mysterious kind and that heat is a mode of motion; but these are nothing more that hypotheses which suit the present conditions of human knowledge. On the other hand, we know that when a certain effect is produced, the action or presence of the agency, whether electricity or heat or some other impalpable force, is to be inferred. Now this is the same with the impalpable forces of the human mind, such as those we call the inventive faculty and the constructive faculty. Their action is to be inferred from the effects produced, and we should determine whether one or the other has acted in a given case by the nature of the

effect, instead of attempting to classify the effects as inventions or as mere skillful constructions falling short of invention, by the assumption that in some cases the inventive faculty has been exercised, while in others only the constructive faculty has acted—an assumption which is incapable of proof in every case and is a matter of mere opinion.

Mr. Robinson says in his work on patents (1 Rob., 114), that "an invention is an unchangeable fact to which the law must conform." If this be true, then that fact, like any other fact, must be susceptible of proof by evidence, and should not be determined by the mere opinion of the Court before whom the question of invention is tried.

We contend, without fear of successful contradiction, that in patent cases the question of invention or no invention is purely a question of fact, and consequently, must be decided by the jury upon the evidence produced *pro* and *con*.

Mr. Walker, a standard text-writer, says at Sec. 42 of his work on patents:

"The question of invention is a question of fact and not of law."

He cites several *nisi prius* decisions which sustain him in the statement.

The best expression of the rule we have been able to find is that made by Mr. Justice Clifford in the opinion rendered by him in *Simpson* vs. *Woodman*, 10 Wall., 125, where he says:

"Patented inventions which are not new and use-
"ful, or which did not require any invention as com-
"pared with what existed, and was in use before,
"may doubtless be held invalid on that account, but
"the question whether a particular invention is new
"and useful, or whether it did require any invention
"to produce it, as compared with what existed be-
"fore, *are everywhere admitted to be questions of*
"*fact for the jury,* and certainly no such question is
"open here for the determination of this Court under
"this bill of exceptions."

It is true that this was said in a dissenting opinion, but it was not on that point that the original opinion was based, and in view of that fact, as well as the fact that Mr. Justice Clifford was one of the most eminent expounders of patent law that ever sat on any bench, we think we are justified in asuming that his statement of the law on this point was correct. He cites several decisions, and also a text-book to sustain him, and upon reference thereto we find that the citations are apt.

We are perfectly free to admit that where a patent is void on its face as being entirely destitute of the inventive faculty, it has been held that the Court may declare it void for that reason. That is to say, the patent itself furnished the evidence on which to base the conclusion of invalidity. Such a patent was involved in *Brown* vs. *Piper,* 91 U. S., 97, another in *Fond Du Lac County* vs. *May,* 137 U. S., 396, and

several other instances might be cited. Such a rule is in accord with our contention, for it will be observed that in all such cases the fact of no invention was determined by evidence, and that evidence was furnished by the patent itself instead of being extrinsic to the patent.

But in the case at bar we find a different state of facts. Cramer's patent does not furnish on its face any evidence of invalidity for want of invention or any other cause. *It was necessary to produce extrinsic evidence to show the prior existence of rotating and revolving shafts mounted in rigid bearings in saw-mills, machine lathes, and high speed engines.* Witnesses were called to testify to those facts, and then experts were called who testified as to the effect of those facts, all of which evidence was properly submitted to the jury for its determination. According to the rule of law announced by the opinion in this case, after this evidence had been introduced at the trial below, it was the duty of the trial judge to have decided judicially that the existence of those facts had been proven and their effect was to preclude the existence of invention in Cramer, and consequently to have instructed the jury to find his patent void for that reason. In other words, the opinion holds that the trial judge should have taken away from the jury a consideration of those questions of fact and decided them himself, thereby depriving us of a

right to a jury trial. Beyond all doubt it was the province of the jury to pass upon those facts regarding saw-mills, lathes, and steam engines, to determine whether or not the evidence of their existence was sufficient, whether the witnesses were telling the truth, and whether or not, assuming that the witnesses did tell the truth, those prior devices related to arts which were sufficiently near and analogous to the sewing machine art to justify them in holding that the use of a similar device in a sewing machine was nothing more than a double use. Those matters were submitted to the jury and the jury held that in their judgment saw-mills, lathes, and steam engines were too remote and too far removed from the sewing machine art to constitute analogous devices. Did not the jury have a right to do this under the Constitution and the laws of the land? Was it not a proper exercise of the functions of the jury, and was not Cramer entitled as a matter of right to the exercise of such functions? If an affirmative answer be proper to these queries, then does it not follow as an irresistible conclusion that upon a writ of error these matters of fact are not reviewable by this Court? The matter so appears to us. At any rate, we claim the right to argue this question *in extenso* before the Court, inasmuch as it never has been argued by counsel on either side, and inasmuch as our excuse for not arguing it heretofore is that it was not relied on nor argued by counsel for the Singer Company.

3. *But even if this question of invention or no invention were open for consideration, it appears to us that the decision in this case is erroneous.*

We recognize the general rule of law that it is no invention to apply an old contrivance to a new use. This is technically called "double use." The doctrine was first announced by Lord Abinger in *Losh* vs. *Hague*, 1 Webs. Pat. Cas., 202, where it is said:

"But it would be a very extraordinary thing to "think that because mankind has been accustomed to "eat soup with a spoon, a man might take out a pat- "ent because he says you might eat peas with a "spoon."

Judge Story mentions several striking instances in *Bean* vs. *Smallwood*, 2 Robb., 133, where he says:

"A coffee-mill applied for the first time to grind "oats, or corn, or mustard, would not give a title to "a patent for the machine. A cotton-gin applied "without alteration to clean hemp, would not give a "title to a patent for the gin as new. A loom to "weave cotton yarn would not, if altered, become a "patentable machine as a new invention by first "applying it to weave woolen yarn. A steam "engine, if ordinarily applied to turn a grist-mill, "would not entitle a party to a patent to it, if it were "first applied by him to turn the main wheel of a cot- "ton factory."

And so, likewise, Judge Blatchford, in the case of *Strong* vs. *Noble*, 3 Fifh., 586, when speaking of the

application of old things to new uses, where no invention was involved, says:

"Such applications are of this character—using an "umbrella to ward off the rays of the sun, it having "been before used to keep off the rain; eating peas "with a spoon, it having been before used to eat soup "with; cutting bread with a knife, it having been "before used to cut meat with."

Such instances are plainly cases of double use, but the law is well settled that the application of an old contrivance to a new use may amount to invention where the new use is not so cognate or analagous to the old as to follow therefrom as a matter of obvious reasoning. Where there is no logical connection between the two, but on the contrary a "logical chasm," and the mind must leap across that chasm in order to arrive at the new use, in such case the result is reached by what Mr. Justice Mathews has styled, in *Hollister* vs. *Benedict,* the inventor's "happy flash of thought," and is, therefore, patentable. In such cases the invention consists in the conception and selection of the new use and nothing else. Or, to put it in another way, where the new use is not analagous to the old, but is in a distant and dissimilar art, then the application of the old contrivance to the new use is patentable.

Thus in *Railroad Co.* vs. *Truck Co.*, 110 U. S., 490, this Court, through Mr. Justice Gray, held that

it was no invention to apply to a locomotive a certain form of truck which had already been applied to railway cars.

And so, likewise, in *Brown* vs. *Piper*, 91 U. S., 37, it was held by this Court, through Mr. Justice Swayne, that it was no invention to apply to the preservation of fish an old process which had been used by undertakers to preserve human corpses.

On the other hand, in *Mowry* vs. *Whitney*, 14 Wall., 620, it was held by this Court, in an opinion delivered by Mr. Justice Strong, that a process for annealing cast-iron railroad wheels involved invention, although the same process had been theretofore applied to speculum metal, and other iron castings, but never to railroad car wheels.

The same ruling was made by Mr. Justice Tyndal in the English case of *Crane* vs. *Price*, 1 Webs. Pat. Cas., 277, where the invention consisted solely in the use of a hot air blast with anthracite coal in the smelting of iron, notwithstanding the fact that a hot air blast had been previously used with bituminous coal in the smelting of iron.

The whole subject was considered by this Court in the case of *Potts* vs. *Creager*, 155 U. S. 606, wherein the opinion was rendered by Mr. Justice Brown. We quote therefrom as follows (the italics being ours):

"What then did the patentees do? They took the "cylinder shown in the Creager wood-polishing ex-

" hibit, removed the glass bars, and substituted bars
" of steel; provided it with an abutting surface in the
" form of a revolving roller, and used it for a totally
" distinct and different purpose. Putting aside, for
" the purposes of this discussion, the fact that the
" Creager cylinder was an abandoned experiment,
" did this involve invention? Certainly, if this ex-
" hibit does not anticipate, none of the others do.
" The answer to this requires the consideration of
" the often recurring question, which has taxed the
" ingenuity of courts ever since the passage of the
" Patent Act, as to what invention really is. When
" a patented device is a mere improvement upon an
" existing machine, and the case is not complicated
" by other anticipating devices, the solution is ordi-
" narily free from difficulty. But where the al-
" leged novelty consists in transferring a device from
" one branch of industry to another, the answer de-
" pends upon a variety of considerations. In such
" cases we are bound to inquire into the remoteness
" of the relationship of the two industries; what al-
" terations were necessary to adapt the device to its
" new use, and what the value of such adaptation has
" been to the new industry. If the new use be ana-
" logous to the former one, the court will undoubted-
" ly be disposed to construe the patent more strictly,
" and to require clearer proof of the exercise of the
" inventive faculty in adapting it to the new use—
" particularly if the device be one of minor import-

" ance in its new field of usefulness. On the other " hand, if the transfer be to a branch of industry but " remotely allied to the other, and the effect of such " transfer has been to supersede other methods of do- " ing the same work, the court will look with a less " critical eye upon the means employed in making the transfer. Doubtless, a patentee is entitled to " every use of which his invention is susceptible, " whether such use be known or unknown to him; " but the person who has taken his device, and, by " improvements thereon, has adapted it to a different " industry, may also draw to himself the quality of " inventor. If, for instance, a person were to take a " coffee-mill and patent it as a mill for grinding " spices, the double use would be too manifest for se- " rious argument. So, too, this court has denied in- " vention to one who applied the principle of an ice- " cream freezer to the preservation of fish, *Brown* " vs. *Piper*, 91 U. S., 37; to another who changed the " proportions of a refrigerator in such manner as to " utilize the descending instead of the ascending cur- " rent of cold air, *Roberts* vs. *Ryer*, 91 U. S., 150; to " another who employed an old and well known " method of attaching car-trucks to the forward " truck of a locomotive engine, *Pennsylvania Rail-* " *road* vs. *Locomotive Truck Co.*, 110 U. S. 490; and " to still another who placed a dredging screw at the " stem instead of the stern of a steamboat, *Atlantic* " *Works* vs. *Brady*, 107 U. S., 192. In *Tucker* vs.

" *Spalding,* 13 Wall., 453, the patent covered the use " of movable teeth in saws and saw plates. A prior " patent exhibited cutters of the same general form " as the saw teeth of the other patent, attachable to a " circular disk, and removable as in the other, the " purpose of which patent was for the cutting of " tongues and grooves, mortises, etc. The court held " that if what it actually did was in its nature the " same as sawing, and its construction and action sug- " gested to the mind of an ordinarily skilled mechan- " ic this double use to which it could be adapted " without material change, then such adaption to a " new use was not a new invention, and was not " patentable.

" Upon the other hand, we have recently upheld a " patent to one who took a torsional spring, such as " had been previously used in clocks, doors, and " other articles of domestic furniture, and applied it " to telegraph instruments, the application being " shown to be wholly new. *Western Electric Co.* vs. " *La Rue,* 139 U. S., 601. So, also in *Crane* vs. *Price,* " Webster's Pat. Cas., 409, the use of anthracite coal " in smelting iron ore was held to be a good inven- " tion, inasmuch as it produced a better article of " iron at a less expense, although bituminous coal had " been previously used for the same purpose. See " also *Steiner* vs. *Heald,* 6 Exch., 607.

" Indeed it ofen requires as acute a perception of " the relation between cause and effect, and as much

" of the peculiar intuitive genius which is a charac-
" teristic of great inventors, to grasp the idea that a
" device used in one art may be made available in
" another, as would be necessary to create the device
" *de novo*. And this is not the less true if, after the
" thing has been done, it appears to the ordinary
" mind so simple as to excite wonder that it was not
" thought of before. The apparent simplicity of a
" new device often leads an inexperienced person to
" think that it would have occurred to any one famil-
" iar with the subject; but the decisive answer is that
" with dozens and perhaps hundreds of others labor-
" ing in the same field, it had never occurred to any
" one before. The practised eye of an ordinary
" mechanic may be safely trusted to see what ought
" to be apparent to every one. As was said by Mr.
" Justice Bradley, in *Loom Company* vs. *Higgins*,
" 105 U. S., 580, 591: 'Now that it has succeeded,
" 'it may seem very plain to any one that he could
" 'have done it as well. This is often the case with in-
" 'ventions of the greatest merit. It may be laid
" 'down as a general rule, though perhaps not an in-
" 'variable one, that if a new combination and ar-
" 'rangement of known elements produce a new and
" 'beneficial result never attained before, it is evi-
" 'dence of invention.'

" As a result of the authorities upon this subject, it
" may be said that, if the new use be so nearly anal-
" ogous to the former one, that the applicability of

" the device to its new use would occur to a person of " ordinary mechanical skill, it is only a case of " double use, but if the relations between them be re- " mote, and especially if the use of the old device " produce a new result, it *may* at least involve an ex- " ercise of the inventive faculty. Much, however, " must still depend upon the nature of the changes " required to adapt the device to its new use."

In view of the law as announced in this last cited case, we respectfully submit that the mounting of a treadle in the solid casting of a sewing machine was not an analogous use to the mounting of revolving and oscillating shafts in saw arbors, machine lathes, and high speed engines. In other words, a sewing machine is not analogous to a saw mill, a machine lathe, or a steam engine, and these devices are too remote and distant to furnish the basis for a conclusion of law that the use of any particular device in them would naturally and spontaneously suggest itself to the mind of a person building a sewing machine. For more than half a century treadles had been mounted in sewing machines in various and sundry ways, but never until Cramer appeared had they been mounted in the vertical brace, and this, too, notwithstanding the palpable fact that the old methods of mounting were bad and produced a rattling noise and much lost motion. Saw-mills, machine lathes, and high speed engines were known to the various experts in the sewing machine art, and yet none of

them ever conceived the idea of mounting the treadle of his sewing machine in an analogous way. If it was a matter of such obvious reasoning, and one which readily recommended itself to the mind of a mechanic, as the opinion of this court makes it out to be, why is it that it was never done until 1880 by Cramer after the primary patents on sewing machines had expired and that colossal fortune had been made in the sewing machine art which transformed Mr. Singer from a pauper mechanic into a merchant prince? The very simplicity of the contrivance ought to be its chief merit, and yet that feature of it is used for our undoing. In this connection we venture to call this court's attention to the impressive language used by Mr. Justice Brown in the case of *Dubois* vs. *Kirk*, 158 U. S., 63:

"The Kirk invention is undoubtedly a very simple "one, and it may seem strange that a similar method "of relieving the pressure had never occurred to the "builders of bear-trap dams before; but the fact is "that it did not, and that it was not one of those obvi- "ous improvements upon what had gone before, "which would suggest itself to an ordinary work- "man, or fall within the definition of mere mechan- "ical skill. It was in fact the application of an old "device to meet a novel exigency and to subserve a "new purpose. That it is a useful improvement can "scarcely be doubted."

Also to the language of Mr. Justice Clifford in *Loom Co.* vs. *Higgins,* 105 U. S., 591, where Webster's celebrated loom patent was attacked on the ground that it was void for want of invention. The learned Justice said:

"This argument would be sound if the combination claimed by Webster was an obvious one for attaining the advantage proposed—one which would occur to any mechanic skilled in the art. But it is plain from the evidence and from the very fact that it was not sooner adopted and used, that it did not for years occur in this light to even the most skillful persons. It may have been under their very eyes, they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value and to bring it into notice. Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produces a new and beneficial result never attained before, it is evidence of invention."

This language was quoted by Mr. Justice Brown with approval in the case of the *Barbed Wire Patent,* 143, U. S., 283.

In conclusion we submit that the conception or idea of mounting the treadle of a sewing machine in

the vertical double brace was not a mere double use, and that it did amount to invention. If that is true, then the Cramer claim is entitled to a broad construction, and the conclusion reached in the opinion of this court will necessarily fall. The whole contention is as to the scope of Cramer's actual invention. Undoubtedly the broad feature of it is the mounting of the treadle in the brace. This broad idea the opinion says did not involve invention. We have undertaken to show that it did involve invention, and if we are correct in that contention, then the opinion must be wrong. In other words, we submit that there are two fundamental errors in the opinion, viz: (1) *The holding that the question of infringement was one of law and not of fact;* (2) *The holding that the broad idea of locating the treadle in the brace did not involve invention.* These are the two premises from which the conclusion of the opinion is deduced, and we freely admit that if these premises are logical and sound, then the conclusion is correct. But we earnestly contend with all the force we possess, that these two premises are not sound, and consequently, that the conclusion drawn therefrom is erroneous. For which reason we ask for a reargument of this case so that it may be carefully considered in the light of the decisions of this court hereinabove cited and of the arguments hereinabove advanced.

Another thought is pertinent in this connection, and that is the moral aspect of the case. Is it possible that this court paid no attention to the moral aspect of this case—has viewed with unconcern the conduct of the Singer Company in their adoption of the device in question?

The record shows that immediately after the granting of his patent Cramer wrote to the Singer Company informing them thereof and calling their attention to the advantage of mounting the treadle in the brace. They replied to him, practically, by stating that they saw no merit in it and did not care to use such a device. And yet within a few months thereafter we find them adopting the device of mounting the treadle in the brace, varying only in details of construction from the form shown in the Cramer patent. There is no question that they first got the idea of mounting the treadle in the brace from Cramer, and it is equally apparent that they used that idea with only slight variations in details of construction, with the intent and purpose of evading the payment of any tribute to the Cramer patent. This is but another instance of the greed of a rich and powerful corporation seeking to get the benefit of a patentee's genius without paying therefor. This is what we mean by the moral aspect of the case. While we do not mean to be understood as contending that Cramer should receive compensation if he has no just claim, we do mean to say that after a litigation of

ten years and seven different hearings and the adjudication of the validity of his patent by a jury, affirmed by a court of appeals, if it be that the questions before this court are doubtful ones, then the moral aspect of the case ought to be sufficient to induce the court to give the benefit of the doubt to the patentee. According to the Constitution, patents are grantable for the purpose of promoting the progress of science and the useful arts, and as a means towards attaining that end the true rule of law is to give the benefit of every doubt to the patentee and not by refinements of reasoning and strained construction to whittle away his invention and thereby enable others to take the substance of it without infringing the patent.

Nor do we fail to note the fact that the Singer Company, while perfectly willing to infringe upon the rights of others, are swift to resent any invasion of their own rights. In the two cases of *Singer Manufacturing Company* vs. *June Manufacturing Company*, and *Singer Manufacturing Company* vs. *Bent*, 163 U. S., 169, and 205, in which cases the opinions were rendered by Mr. Justice White, we find that the Singer Company was awarded injunctions, together with decrees for accountings of enormous profits against two of its rivals, who had infringed upon the rights of the Singer Company by the use of the word "Singer" as applied to these same identical machines involved in the case at bar and charged by us to be an infringement of the Cramer patent. This

court had no hesitancy in awarding to the Singer Company the relief to which it was entitled in respect of its Diehl machines, and yet those same machines practically owe their life and existence to the valuable and fundamental idea which Mr. Cramer communicated to the Singer Company by the letters appearing in this record. These are not idle assertions, for to any one of a mechanical turn, the fact must be apparent that the fundamental idea of the Diehl machine, and the one which more than all others contributes to its merit and utility, is the broad idea of mounting the treadle in the vertical base, an idea which none of the Singer Company's skilled mechanics seem ever to have dreamed of until Mr. Cramer communicated it to them.

Again, we fear that the magnitude of this case disturbed the equanimity of the court and acted to our prejudice. The Singer Company advertises that they have sold several millions of machines embodying the Diehl construction. The jury in this case fixed as a royalty for Cramer one dollar for each machine. This particular case is a test case, and if the judgment had been affirmed, the Singer Company would have had to account to us for the royalty on several million machines. This fact was adverted to by the counsel for the Singer Company in his printed brief in this court on his application for a writ of *certiorari*, and if he was justified in referring to it, we claim an equal right to do so on this petition

for a rehearing. We sincerely trust that the magnitude of the issue had no influence with the court. At the same time we cannot refrain from opining that if the only issue involved had been the verdict of $12,450, rendered by the jury, we might possibly have had a better chance of securing an affirmance of the judgment.

III.

Another reason occurs to us as justifying the request for a rehearing, and it is this: At the argument of this case only seven justices were present, the other two being absent on account of illness. Since the argument and submission of the case an additional justice has been appointed, but inasmuch as he did not hear the argument, he probably did not participate in the decision. Consequently, this leaves only six justices to participate in the decision. In a case of this magnitude, involving issues of such vital interest, we submit that we are entitled to a hearing by the full bench. Such a hearing we have not had. We have had only six members of the bench to hear the argument and participate in the decision.

It is not our custom, as it is with that of some practitioners, to condemn every decision merely because it is adverse to our interests. We flatter ourselves that our mind is sufficiently free of partisanship to enable us to recognize and appreciate the correctness

of a decision even when adverse to our interests. For this reason we seldom apply for rehearings in any court and can recall only a few instances thereof in our practice. In the present case we feel constrained to deviate from that practice because we feel deeply aggrieved by the decision and think that we have been too harshly treated. It appears to us that by some unaccountable oversight the court has fallen into a most grievous error, which ought to be corrected. In our judgment the decision in this case establishes a new rule in patent law irreconcilably at war with all the prior adjudications of this court on the subject, and that, too, without a hearing or argument on the point from either counsel in the case.

We understand the rule as to rehearings to be the same now as when announced by Chief Justice Taney in 1852 (*Brown* vs. *Aspden*, 14 How. 27), viz., that where a member of the court who concurred in the judgment desires a reargument, the same will be ordered. Under this rule we earnestly appeal to all the members of the court who concurred in this judgment, hoping that of the number there may be found one who will consider the matter of sufficient gravity to justify him in requesting a re-argument.

Respectfully submitted,

JOHN H. MILLER,
Counsel for Respondent.

San Francisco, Feb. 15, 1904.

CERTIFICATE.

I, JOHN H. MILLER, counsel for Herman Cramer, Respondent in the foregoing case, hereby certify that in my opinion the foregoing petition for a rehearing is well founded in point of law and ought to be granted.

JOHN H. MILLER.